

Pollen Quantity: Little

Fruit and Seeds: None observed--.

REMARKS

I. The Section 112 Rejection

The Examiner has objected to the disclosure under 37 C.F.R. §1.63(a) and under 35 U.S.C. § 112, first paragraph, on the basis that “the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.” Claim 1 stands rejected under 35 U.S.C. § 112, first and second paragraphs, as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Examiner’s objection to the disclosure.

The specification has been amended, as suggested by the Examiner, to make a full and complete disclosure of the plant and the characteristics that distinguish it from other related known varieties and antecedents. With reference to the enclosed red-lined version, at page 3, line 8, the U.S. plant patent number for the patented variety ‘Canton’ has been inserted. Also at page 3, line 11, a spacing error has been corrected and at line 16, the word “parent” has been deleted since ‘Canton’ is not a parent cultivar of the instant variety.

At page 5, lines 1-3, the specification has been amended to recite that there have been no observations of susceptibility or resistance regarding disease, pest, drought or temperature.

At page 6, line 1, the spacing has been corrected and at line 18, “Sepals” has been changed to ‘Phyllaries.’ A typographical error has been corrected at page 7, line 9, changing “Florets,” to “florets.”

The section entitled Reproductive Organs at page 8 has been amended as suggested by the Examiner to clarify the disclosure in terms of the observed gynoecium and androecium. In addition, at page 8, the specification has been amended to indicate that the characteristics of fruit and seeds for the instant plant variety have not been observed.

There are no amendments to the claim or Abstract.

The above amendments to the specification have addressed the Examiner's objections to the disclosure under 37 C.F.R. §1.63 and under 35 U.S.C. § 112, first paragraph. It is respectfully submitted that those objections are now overcome. As a consequence, the basis for the Examiner's rejection under 35 U.S.C. § 112, first and second paragraphs, is no longer present and it is respectfully requested that the rejection on this basis be withdrawn.

II. The Section 102(b) Rejection

Claim 1 stands further rejected under 35 U.S.C. § 102(b) over a Plant Breeders' Right ("PBR") application and catalog provided by the Applicant in view of "the applicant's admission that the claimed plant was placed in the public domain more than one year prior to the U.S. filing date of the instant application." (See page 5 of the Office Action dated December 18, 2002.)

As to the PBR application provided by the Applicant, the variety 'Tutan Time' is the subject of an application in the Netherlands that was filed more than one year prior to the filing date of this U.S. application. Applicant has also disclosed a partial copy of a Ficor 2000 catalog in which the variety that is the subject of this U.S. application was offered for sale outside the U.S. more than one year prior to the U.S. filing date. (A complete copy of the catalog is attached here for the convenience of the Examiner.) The catalog was publicly distributed in Ireland and the United Kingdom.

Although the Examiner's Office Action does not discuss the basis for the rejection in any

detail, the Examiner has apparently relied upon the PBR application and the 2000 catalog of limited geographic distribution and restricted sales outside the United States as printed publications under 35 U.S.C. § 102. The Examiner has also apparently relied upon the catalog as evidence that the variety was placed in the public domain more than one year prior to the filing of this application. Consequently, Claim 1 has been rejected under § 102(b) as allegedly anticipated by the Netherlands PBR application and the Ficor catalog in combination with purported knowledge in the prior art of the availability of the variety outside the U.S. that would enable one of ordinary skill in the art to reproduce the claimed plant.

A. For § 102(b), A Reference Must Place the Public in Possession of the Invention

Anticipation by a reference occurs when the reference adequately describes the invention in question to a person of ordinary skill in the art to which the invention pertains and the reference qualifies as a printed publication. *See, e.g., In re Paulsen*, 30 F.3d 1475, 1478 (Fed. Cir. 1994) (“the reference must be enabling and describe the applicant’s claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention”). *See also In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962) (“We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention.*”) (Italics in original.)

The description must enable such a person not only to comprehend the invention but also to make it. *Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 665 (Fed. Cir. 1986) (“[A] § 102(b) reference ‘must sufficiently describe the claimed invention to have placed the public in possession of it.’ . . . ‘[E]ven if the claimed invention is disclosed in a

printed publication, that disclosure will not suffice as prior art if it was not enabling.” . . . The basis for this rule is found in the description requirement of § 102(b).”)

The standards as to what constitutes a “publication” are well established in the case law. Quoting *Seymour v. Osborne*, 78 U.S. 516, 555 (1870), the CCPA in *LeGrice* set forth the controlling view:

Patented inventions cannot be superseded by the mere introduction of a foreign publication of the kind, though of prior date, unless the description and drawings contain and exhibit a substantial representation of the patented improvement, in such full, clear, and exact terms as to enable any person skilled in the art or science to which it appertains, to make, construct, and practice the invention to the same practical extent as they would be enabled to do so if the information was derived from a prior patent. Mere vague and general representations will not support such a defence, as the knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use. Whatever may be the particular circumstances under which the publication takes place, the account published, to be of any effect to support such a defence, must be an account of a complete and operative invention capable of being put into practical operation. *LeGrice*, 301 F.2d at 936, 133 USPQ at 371.

B. For § 102, All Elements of the Invention Must Be Found In A Single Reference

For anticipation, a reference must disclose all elements of the claimed invention within the four corners of the reference. *Advanced Display Systems Inc. v. Kent State University*, 212 F.3d 1272, 1282 (Fed. Cir. 2000), *cert. denied*, 532 U.S. 904 (2001) (“invalidity by anticipation requires that the four corners of a single, prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation.”) Anticipation cannot be found by combining more than one reference to show the elements of the claimed invention. *In re Saunders*, 444 F.2d 599, 602-03 (CCPA 1971) (“[T]wo references together simply cannot constitute an ‘anticipation’ in the technical sense of that term in patent law.”) “It is hornbook

law that anticipation must be found in a single reference, device or process.” *Studiengesellschaft Kohle, m.b.H. v. Dart Indus., Inc.*, 726 F.2d 724, 726-27 (Fed. Cir. 1984).

Although all elements of the claimed invention must be shown in a single reference, the Federal Circuit has noted that “it is sometimes appropriate to consider extrinsic evidence to explain the disclosure of a reference.” *Scripps Clinic & Research Foundation v. Genetech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). *See also In re Samour*, 571 F.2d 559 (CCPA 1978) (a primary reference disclosing all the elements of a chemical compound anticipates a later claim for that compound even though a method of making the compound is disclosed only in a secondary reference). In *Scripps*, however, the Federal Circuit went on to warn that the use of such extrinsic evidence is narrowly proscribed.

Such factual elaboration is necessarily of limited scope and probative value, for a finding of anticipation requires that all aspects of the claimed invention were already described in a single reference: a finding that is not supportable if it is necessary to prove facts beyond those disclosed in the reference in order to meet the claim limitations. The role of extrinsic evidence is to educate the decision-maker to what the reference meant to persons of ordinary skill in the field of the invention, not to fill gaps in the reference. . . . If it is necessary to reach beyond the boundaries of a single reference to provide missing disclosure of the claimed invention, the proper ground is not § 102 anticipation but § 103 obviousness. *Scripps*, 927 F.2d at 1576-77 (citations omitted).

Even so, such “[e]xtrinsic evidence may be considered when it is used to explain but not to expand, the meaning of a reference.” *In re Baxter Travenol Labs*, 952 F.2d 388, 390 (Fed. Cir. 1991). Moreover, it is not permissible to incorporate specific teachings of a second reference into an allegedly anticipating reference. *See In re Marshall*, 578 F.2d 301, 304 (CCPA 1978) (“[T]o constitute an anticipation, all material elements recited in a claim must be found in one unit of prior art. . . . This basic principal of patent law has not been disturbed by our recent decision, *In re Samour* . . . in which we affirmed a § 102(b) rejection of claims to a chemical compound based on a primary reference which disclosed the compound and additional references

which established that a method of preparing the compound would have been obvious to one skilled in the art. In *Samour*, every material element of the claimed subject matter, the chemical compound, could be found in the primary reference, a disclosure of the compound.”) *See also Al-Site Corp. v. Opti-Ray Inc.*, 28 USPQ2d 1915, 1921 (E.D. N.Y. 1993) (“it is inappropriate for the fact-finder to go beyond the features of a prior art reference in order to find that that reference anticipated the patented invention.”)

C. Foreign Public Use and On-Sale Activity Is Not Prior Art Under § 102(b)

Public availability or on-sale activity of an invention in a foreign country is not a factor in determining patentability under 35 U.S.C. § 102(b). Until an invention is described in a printed publication or patented outside the United States, the foreign use is not deemed to have made the invention available in this country. *See* § 102(b) (barring patentability if an invention was “in public use or on sale in this country, more than one year prior to” an application. It is only the public use or sale of an invention in the United States that can affect the patentability of that invention under 35 U.S.C. § 102(b).

Moreover, using the sale of an invention in a foreign country as extrinsic evidence to augment the otherwise insufficient disclosure of a printed publication is merely an attempt to overcome the limitations of 35 U.S.C. § 102(b). An inadequate reference cannot be used as a vehicle for an improper rejection under § 102(b) based upon a sale of the invention outside the United States. *See, e.g., In re Baxter Travenol Labs*, 952 F.2d at 390 (extrinsic evidence can be used to explain but not expand a reference). A foreign sale or public use of an invention, without more, is not prior art under 35 U.S.C. § 102(b). Renaming it as “common knowledge” in the art and joining it with an otherwise non-enabled reference does not make the combination viable prior art. *See, e.g., Al-Site Corp. v. Opti-Ray Inc.*, 28 USPQ2d at 1921 (inappropriate to go

beyond the disclosure to find anticipation by a reference).

D. The Published Netherlands PBR Application

The instant variety 'Tutan Time' is the subject of an application in the Netherlands that was filed more than one year prior to the filing date of this U.S. application. PBR Application No. CHR 3150 was filed in the Netherlands on October 11, 1999 under Breeder's Reference No. 20778-0 but without a proposed common variety denomination. (See, e.g., UPOV-ROM GTITM Computer Database 2002/01, January 1, 2002, GTI Jouve Retrieval Software, citation for Application No. CHR 3150, Chrysanthemum Breeder's Reference No. 20778-0, attached as item 8 to the First Supplemental Information Disclosure Statement filed October 11, 2002.) A citation to the PBR application was published in Publikatieblad, the Official Gazette of the Raad voor het Kwekersrecht (the Netherlands Board for Plant Breeders' Rights) on November 16, 1999. (See item 9 attached to the First Supplemental Information Disclosure Statement filed October 11, 2002.) The common variety denomination 'Tutan Time' was subsequently proposed in Application No. CHR 3150 during 2002 and hence was not published in Publikatieblad until well after the U.S. filing date. (See First Supplemental Information Disclosure Statement filed October 11, 2002.)

A certified copy of the Netherlands Application No. CHR 3150, bearing the certification date of October 10, 2002, was attached to Applicant's Second Supplemental Information Disclosure Statement filed November 15, 2002. The application is partially in Dutch and a complete English translation is not available. Based on information from the Netherlands Board of Plant Breeders' Rights, Applicant's attorney understands that certified copies of the application became available to the public under Application No. CHR 3150 and Breeder's Reference No. 20778-0 when the application was published in Publikatieblad on November 16,

1999. It is further understood that certified copies of the application were not catalogued, and hence not available to the public, under the common variety denomination ‘Tutan Time’ until the denomination was published in Publikatieblad in 2002.¹

E. The Netherlands Application is Not Effective Prior Art for Anticipation

In this U.S. application for the ‘Tutan Time’ variety, the Netherlands PBR application is insufficient to place a person of ordinary skill in the art in possession of the claimed variety. The published application clearly lacks enablement since it does not teach one of ordinary skill in the art how to make the plant variety in question. *See LeGrice*, 301 F.2d at 944, 133 USPQ at 378 (mere description of a plant is not an enabling disclosure). The information disclosed in the application, whether detailed or not, is inadequate to place the variety in the possession of one of ordinary skill in the art. As a consequence, the Netherlands application alone cannot form the basis of a § 102(b) anticipation rejection.

F. The Ficor Catalogs Are Insufficient to Place the Public In Possession of the Claimed Variety

The instant variety was offered for sale outside the United States more than one year prior to the U.S. filing date under the name ‘Tutan Time’ in the Ficor 2000 catalog. As noted in Applicant’s First Supplemental Information Disclosure Statement filed October 11, 2002, Applicant is not aware of any sale or public distribution in the United States more than one year prior to the U.S. filing date. The Examiner, however, has apparently relied on the Ficor 2000 catalog as a printed publication under 35 U.S.C. § 102(b) and as evidence that the variety was publicly available outside the United States more than one year prior to the U.S. filing date.

¹ A complete translation of the certified application is not available, however, an informal translation of paragraph 8 on the first page indicates that the variety was available or offered in the Netherlands on March 1, 1999 under the name “Tutan Time” (paragraph 8a) but not outside

As a printed publication, the Ficor 2000 catalog suffers from the same general defects as the Netherlands PBR application. The catalog clearly lacks enablement since it does not teach one of ordinary skill in the art how to make the plant variety in question. *See LeGrice*, 301 F.2d at 944, 133 USPQ at 378 (mere description of a plant is not an enabling disclosure). Because the catalog is not enabling, the information disclosed in the catalog is inadequate to place the variety in the possession of one of ordinary skill in the art. As a consequence, the catalog alone cannot form the basis of a § 102(b) anticipation rejection.

In addition, the catalog suffers from further defects beyond those of the Netherlands PBR application. The description regarding the ‘Tutan Time’ variety disclosed in the Ficor 2000 catalog is minimal at best. For example, in the Ficor 2000 catalog, ‘Tutan Time’ first appears as a new variety in an alphabetical listing at page 4 of the catalog and then at page 11 with twenty four other varieties under the general page heading “Pot Varieties.” The Pot Varieties are divided into three tables and ‘Tutan Time’ is listed in a table entitled “Yellow Decorative” with thirteen other varieties.

The table of Yellow Decoratives is largely devoid of any substantive description of the ‘Tutan Time’ variety that would clearly distinguish it from the twelve other Yellow Decorative varieties listed there. Aside from the name of the variety, the table gives only six discrete pieces of information regarding each variety listed, three of which relate to royalty rate and plant availability from the distributor. A column in the table entitled “Notes” contains a subjective and cryptic evaluation of each variety that adds little in the way of distinction. For ‘Tutan Time’ the entry reads in full: “Gold bronze single with quilled petals and green disc.” For other varieties listed in the table, the Notes column contains similar generic comments, for example, “Lemon

the Netherlands at the time of filing (paragraph 8b). There is no indication in paragraph 8 of

yellow decorative with darker centre.” and “Large golden yellow decorative with good winter response.” There is a picture of the variety on page 15 with an additional comment stating: “A couple of days faster in response at 51 days. Tutan Time has a robust, compact habit smothered in gold spoon-single flowers.” There is no other description of the ‘Tutan Time’ variety in the catalog and no other disclosure directed at distinguishing characteristics, comparisons or contrasts with other varieties.

The 2000 Ficor catalog description alone is simply insufficient to place a person of ordinary skill in the art in possession of the claimed variety. Even setting aside the question of enablement to make the claimed plant variety, the disclosure of the Ficor catalogs for the instant variety is simply too factually deficient to adequately describe the claimed variety with any specificity. In other words, it fails to meet the standards of *Seymour v. Osborne* to qualify as a printed publication.

Although the catalog lists the denomination ‘Tutan Time,’ it otherwise gives few characteristics beyond the name that could be used to distinguish the instant variety from any other “Yellow Decorative” Chrysanthemum listed in the catalogs. The six or so bare pieces of information and the photograph contained in the catalog are simply too sparse to constitute an adequate description of the claimed variety sufficient to place the variety in the possession of one of ordinary skill in the art, without considering the lack of enablement. As a consequence, the catalog alone cannot form the basis of a § 102(b) anticipation rejection. The description is too inadequate and too insufficient to be effective prior art as a printed publication, before even reaching the enablement issue.

how or where to obtain the variety.

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G. The Combination of PBR Application or Ficor Catalog With Foreign Availability Is an Improper Attempt to Overcome the Limitations of § 102(b)

Although the text of the Netherlands PBR application or the Ficor 2000 catalog standing alone would not enable one skilled in the art to make and use the claimed plant variety, the Examiner has relied on the references as printed publications under 35 USC § 102. When a claim is drawn to a plant, a prior art reference, combined with knowledge in the particular art, must enable one of ordinary skill to reproduce the plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962).

Here, although the Office Action is not specific, the Examiner may be relying on *Ex Parte Thomson* for the position that if one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. *See Ex Parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) (“[T]he applied [§ 102(b)] rejection does not rely upon or incorporate the public use or on sale bar of the statute. . . . [T]he material disclosed in each [publication], when considered in conjunction with the knowledge of the skilled cotton grower, would have enabled such a skilled artisan to make the claimed Siokra cultivar, along with its seeds, plants, pollen, etc., by purchase and planting of the requisite seeds.”)

Thus, the Examiner’s position may be that the Netherlands PBR application or the Ficor 2000 catalog would be enabled as a printed publication by evidence that the claimed variety was publicly available, given that there are various well known methods for asexual propagation. Since the instant plant variety was available to the public in the U.K. more than one year prior to the U.S. filing date, according to the Examiner’s position, this would constitute knowledge in the prior art sufficient for enablement upon combination with the Netherlands application or the Ficor catalog. It is apparent, however, that this combination cannot be maintained.

The controlling case authority here is *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). *LeGrice* is a decision from the CCPA, predecessor to the U.S. Court of Appeals for the Federal Circuit, which has recognized CCPA opinions as binding precedent. *South Corp. v. United States*, 690 F.2d 1368 (Fed. Cir. 1982). Even where it is possible that a prior decision of the CCPA would be decided differently today, it still stands as binding precedent until overruled. *In re Durden*, 763 F.2d 1406, 226 USPQ 359 (Fed. Cir. 1985). See also *Larry Harmon Pictures Corp. v. Williams Rest. Corp.*, 929 F.2d 662, 18 USPQ2d 1292 (Fed. Cir. 1991). Moreover, since the CCPA always sat en banc, its decisions may not be overturned by a later Federal Circuit panel, but only by the Federal Circuit setting en banc. *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989).

In *LeGrice*, two plant patent applications for hybrid rose varieties were rejected under § 102(b) on grounds that the varieties had been described in printed publications outside the United States more than a year before their U.S. filing dates. The publications occurred in the National Rose Society Annual of England and in catalogues that included photographs of the hybrid roses. On appeal from the Examiner's final rejections, the Board of Appeals affirmed, and the cases were consolidated for appeal to the CCPA. *Id.*, 301 F.2d at 930, 133 USPQ at 367.

The CCPA reversed the Board of Appeals, holding that the published descriptions of the claimed rose lacked enablement and did not constitute an adequate description of the roses as would bar a plant patent. Focussing on the printed publications, the CCPA reasoned as follows:

In holding that the publications here in issue constitute a legal bar to a granting of patents on the *rosa floribunda* plants described in the applications here on appeal, we think the examiner and the Board of Appeals disregarded what we have found to be the legally imposed limitations on the meaning of the clause "described in a printed publication" in section 102(b) in the prior cases in which the courts have interpreted the clause in determining whether a particular description in a publication will constitute a statutory bar to the grant of a patent. . . [T]his clause requires that the description of the invention in the printed

publication must be an “enabling” description. Our study of the prior cases which have imposed this interpretation on the clause indicates that the proper test of a description in a publication as a bar to a patent as the clause is used in section 102(b) requires a determination of whether one skilled in the art to which the invention pertains could take the description of the invention in the printed publication and combine it with his own knowledge of the particular art and from this combination be put in possession of the invention on which a patent is sought. Unless this condition prevails, the description in the printed publication is inadequate as a statutory bar to patentability under section 102(b). *LeGrice*, 301 F.2d at 938-39, 133 USPQ at 373-74.

With regard to the printed publications and catalogs relied upon for the rejection in *LeGrice*, the CCPA disagreed with the view that its holding meant that plant publications must be “totally ignored,” and focused instead on the “description in the printed publication.”

Instead, it requires that the facts of each case be carefully considered to determine whether the description in the printed publication in question *does in fact* place the invention in the possession of the public. Each case must be decided on its own particular facts in determining whether, in fact, the description in the printed publication is adequate to put the public in possession of the invention and thus bar patentability of a plant under the conditions stated in Section 102(b). While the present knowledge of plant genetics may mean as a practical matter, that the descriptions in such general publications as here are involved cannot be relied upon as a statutory bar under section 102(b), we must be mindful of the scientific efforts which are daily adding to the store of knowledge in the fields of plant heredity and plant eugenics which one skilled in this art will be presumed to possess. *LeGrice*, 301 F.2d at 939, 133 USPQ at 374 (footnote omitted, italics in original).

In the instant case, the circumstances are substantially similar to that in *LeGrice*. The Examiner has rejected claim 1 over a PBR application and a catalog as printed publications in combination with evidence of availability outside the U.S. from overseas catalogs. What makes the Examiner’s position particularly untenable here is that the same circumstances relied upon by the Examiner in the instant application were present forty years ago in *LeGrice* and the CCPA held to the contrary. Indeed, the printed publications relied upon in *LeGrice* also included catalogs advertising the claimed plant varieties. The Court even commented on the catalog descriptions in its opinion. *See LeGrice*, 301 F.2d at 932, 133 USPQ at 368. Thus, although the

Court in *LeGrice* was clearly aware of the catalog listings of the hybrid rose varieties outside the U.S., it failed to find those listings as evidence of foreign availability.

Had the Court considered the catalog listings of the hybrid rose varieties in *LeGrice* to be determinative of enablement, as asserted here by the Examiner, it would have at least acknowledged foreign availability to be an enabling disclosure within the “common knowledge” in the prior art. In fact, the Court made no ruling that foreign availability was enabling, but instead held that “[t]he descriptions of the new roses in the instant publications, are incapable of placing these roses in the public domain by their descriptions *when interpreted in the light of the knowledge now possessed by plant breeders*. The roses disclosed in the appealed applications are not, therefore, ‘described in a printed publication’ within the meaning of 35 U.S.C. 102(b).” *LeGrice*, 301 F.2d at 944, 133 USPQ at 378 (footnote omitted, italics added).

Thus, although the catalog listings of the claimed roses were within the “common knowledge” *then possessed* by plant breeders, the CCPA failed to comment on or even acknowledge that information regarding foreign availability would have been enabling. The CCPA noted instead in footnote 7 that the knowledge of plant breeders was constantly increasing “so that they may *someday* secure possession of a plant invention by a description in a printed publication as is now possible in other fields of inventive effort.” *Id.*, 301 F.2d at 939 n. 7, 133 USPQ at 374 n. 7 (emphasis added).

The CCPA did not have to wait for “someday” to arrive for enablement of published plant descriptions if a disclosure of foreign availability by a catalog would have sufficed. Clearly, a simple disclosure of foreign availability for a plant variety is not part of the constantly increasing “knowledge of plant breeders” contemplated by the CCPA. No “contemporaneous advancement in plant heredity and eugenics” is required for reporting on foreign availability of a

plant variety. Indeed, having had the clear opportunity to rule on the same genre of facts as present in the instant case, the CCPA purposefully chose not to recognize the foreign availability of the claimed varieties as evidence of enablement within the common knowledge in the prior art.

The later case authority relied upon by the Examiner cannot overrule *LeGrice* nor does it attempt to do so. As noted by the CCPA in *LeGrice*, each case is considered on its own merits. *LeGrice*, 301 F.2d at 939, 133 USPQ at 374. In *Ex Parte Thomson*, for example, the Board of Patent Appeals distinguished *LeGrice* on the facts in that case and found anticipation of a *utility* patent by publications describing a Siokra cotton cultivar, even though the publications did not describe the inventor's breeding process. The publications, however, indicated that seeds for the cotton cultivar were widely available outside the U.S. and the Board concluded that the publications were thereby enabled. *Ex Parte Thomson*, 24 USPQ2d at 1620-21 and n. 1.

Moreover, the printed publication at issue in *Thomson* described the claimed plant in sufficient detail to distinguish the variety from all others and place the claimed plant in the possession of a person of ordinary skill but for one issue: enablement to make the plant. There was no dispute regarding the sufficiency of the description of the plant variety otherwise except as to enablement.

That is clearly not the same circumstance in this case. The Ficor catalog in the instant case is too factually spare to comprise an adequate description of the claimed plant even if the lack of enablement is ignored. The publication does not in itself contain sufficient disclosure to distinguish the instant variety from other varieties included there, let alone varieties not part of the catalog. The published description is too meager to place the claimed variety in the possession of one of ordinary skill in the art. In addition, both the Ficor catalog and the

Netherlands PBR application lack enablement.

The evidence of foreign availability of the claimed variety cannot be used to relieve the fatal defects of the printed publications. The Examiner is not using the evidence of foreign availability just to show the state of knowledge in the prior art or explain the PBR application or the catalog disclosures. It is rather being used to fill a multitude of gaps in the description of the invention and expand the printed publications far beyond what they rightfully disclose absent the combination. In effect, the PBR application and catalogs are simply a pretense for rejecting the U.S. application based on the foreign public use and availability.

The Examiner has not made any distinction between the facts of *LeGrice* and those of the current case nor has she asserted any rationale for why the *LeGrice* decision should result in a different outcome based on the similar factual circumstances. Per the reasoning of the *LeGrice* decision, evidence of the foreign availability of a claimed variety is not useful to relieve the inadequate enablement of a printed publication. Despite an ample opportunity to do so, the CCPA in *LeGrice* did not equate foreign availability with enablement of a printed publication, which position is advanced by the Examiner in the instant application. Thus, the Examiner is foreclosed by a contrary result in *LeGrice* on similar facts as in the instant case from using the evidence of foreign availability to prove enablement. That route is incompatible with *LeGrice*.

The Examiner has made a flawed combination for anticipation. Relying on the rationale of *LeGrice*, the public availability of the claimed variety outside the U.S. will not supply the missing enablement of the plant description in the Netherlands application under the guise of a Section 102(b) rejection. Moreover, it is not permissible to use extrinsic evidence to add to a disclosure that is insufficient for anticipation and thereby complete an otherwise inadequate description. Such augmentation is contrary to the Section 102(b) statute and contrary to the case

law on Section 102(b) discussed above.

Under the circumstances, the Section 102(b) rejection here cannot stand. Plant descriptions, “just as in the case of other types of inventions, in order to bar the issuance of a patent, must be capable, when taken in conjunction with the knowledge of those skilled in the art to which they pertain, of placing the invention in the possession of those so skilled. *LeGrice*, 301 F.2d at 944, 133 USPQ at 378. In the instant case, the Netherlands application and the Ficor catalog lack at least enablement to do so, and per *LeGrice*, the Examiner has failed establish otherwise.

III. Conclusion

It is respectfully submitted that the Examiner’s rejections under 35 U.S.C. §§ 112 and 102 have been overcome as lacking in basis and should be withdrawn. There are no further rejections or objections to the disclosure or the claim and the application is now believed to be in condition for allowance. The Applicant respectfully requests that the Examiner reconsider her rejection of this application.

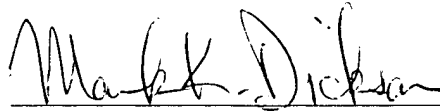
Applicant notes that the Examiner did not include with the December 18, 2002 Office Action an initialed copy of either of the PTO 1449 Forms attached to the Applicant’s previously submitted information disclosure statements. Applicant requests that the Examiner initial and return copies of the PTO 1449 Forms to indicate the information contained there has been reviewed and considered by the Examiner.

No additional fees are believed to be due, however, the U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to Deposit Account No. 08-3038 referencing docket number 10451.0029.NPUS00.

The Examiner is invited to contact the undersigned attorney at (650) 463-8100 or at DicksonM@howrey.com regarding any further questions, comments or suggestions relating to this patent application.

Respectfully submitted,

Date: June 17, 2003

A handwritten signature in black ink, appearing to read "Mark K. Dickson", written over a horizontal line.

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